

REMARKS

This communication is in response to the non-final Office Action issued March 21, 2005. The Examiner rejected claims 1-20 under 35 U.S.C. § 103 in view of U.S. Patent No. 5,833,553 to Sullivan *et al.* (Sullivan '553), either alone or in combination with U.S. Patent No. 6,315,681 to Sullivan (Sullivan '681).

Claim Rejections Under 35 U.S.C. § 103

In sections 1-2 of the Office Action, the Examiner rejected claims 1-20 under 35 U.S.C. § 103 in view of Sullivan '553, either alone or in combination with Sullivan '681. Specifically, the Examiner rejected claims 1-18 in view of Sullivan '553 alone and claims 19 and 20 in view of Sullivan '553 modified by Sullivan '681.

It is well settled that for a rejection of a claim under 35 U.S.C. § 103 to be proper, each and every recitation of the claim must be present in the cited reference(s). See, for example, MPEP § 2143.03. It is also well settled that for a rejection of a claim under 35 U.S.C. § 103 to be proper, there must be some suggestion or motivation to modify a reference or combine reference teachings. See, for example, MPEP § 2143.01. When so modifying a reference, the proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. See, for example, MPEP § 2143.01. The modification must support a reasonable expectation of success with some degree of predictability. See, for example, MPEP § 2143.02. Finally, the source of the suggestion or motivation to modify a reference cannot be the Applicants' own disclosure. See, for example, MPEP § 2143. For at least the reasons stated below, the Examiner's rejections of the claims do not satisfy these burdens.

Sullivan '553 appears to disclose a low spin golf ball having a soft core and a thick, hard cover. "The cover has a Shore D hardness of 60 or more, and preferably at least 64." Col. 2, lines 57-58 (reference character omitted). The cover may contain two or more layers, in which case each of the cover layers "have substantially the same Shore D hardness. In other words the difference between the Shore D hardness of the inner cover layer and outer cover layer is 5 or less, and preferably 2 or less. Each of the inner and outer layers has a Shore D hardness of at least 64." Col. 3, lines 52-57 (reference characters omitted).

The Rejections of Claims 1-14 are Improper and Must be Withdrawn

Claim 1 of the instant application recites *inter alia* that the cover contain two layers with the outer cover layer being substantially translucent and the inner cover layer being substantially opaque. In addressing this translucent recitation, the Examiner first notes that Sullivan '553 discloses that dyes and pigments may be added to the cover and then states "the material in [sic] which is used for the cover layer is ionomer which is inherently transparent." The Examiner fails to address the explicit teachings of the Sullivan '553 reference, which make clear that its golf balls contain no translucent cover layers. For example, Sullivan '553 states:

The cover ... may include fillers.... Dark colored fillers generally are not preferred for use at the outer surface of the ball if a white ball is desired. Thus, a two-layer cover in which a non-white filler is *only present in the inner cover layer* can be employed.

Col. 3, lines 16-34 (emphasis added). In other words, the end product is a white golf ball so dark fillers cannot be used in the outer cover layer. Sullivan '553 further states:

Additional materials may also be added to the cover (or inner and outer cover layers).... Such materials include dyes..., optical brighteners, [and] pigments....

Moreover, since there are various hues of white, i.e. blue white, yellow white, etc., trace amounts of blue pigment may be added to the cover stock composition to impart a blue white appearance thereto. However, if different hues of the color white are desired, different pigments can be added to the cover composition at the amounts necessary to produce the color desired.

....
Moreover, since many optical brighteners are colored, the percentage of optical brighteners utilized must not be excessive in order to prevent the optical brightener from functioning as a pigment or dye in its own right.

Col. 15, line 63 to col. 17, line 40. Thus, Sullivan '553 discloses that dyes and pigments may be added to the cover material in order to achieve varying hues of white. Brighteners may also be added to the cover material, but only in such quantity that the cover remains white. There is no disclosure or suggestion, however, of a translucent cover layer. As such, the rejections of claim 1 and the claims dependent from claim 1 are improper and must be withdrawn.

Additionally, the Examiner's rationale for modifying the Sullivan '553 golf ball is unclear, specifically "so long as the layers are deteriorated." This lack of clarity further requires that the rejections be withdrawn.

Further regarding claims 2-5, the Examiner makes a broad declaration alleging that "Applicant does not teach why approximately 0.065 is critical to attain the invention," and concluding that, therefore, Sullivan '553 "would have resulted in the same properties of that of the applicant's invention." The Examiner cites *Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985) in support of his assertions. This case, however, does not provide support for the Examiner's statement, which is erroneous. The rejection therefore is improper, and must be withdrawn. At issue in the *Titanium Metals* case was a composition claim for a Nickel-Molybdenum-Titanium alloy that recited specific percentages of the alloy elements and additionally recited that the alloy be "characterized by good corrosion resistance in hot brine environments." The Federal Circuit explained that if a known alloy contained the same percentages of the same elements, a new patent cannot be granted on the same composition to one who has discovered a previously unknown useful property of the known composition. In

other words, an applicant cannot obtain a patent on a newly discovered characteristic of a known alloy.

Titanium Metals, however, does not stand for the proposition stated by the Examiner. The case does mention “critical” claim recitations, nor does it impose a burden on a patent applicant to disclose “criticality” of every claim element. The case is further inapplicable here because the Applicants’ claims do not contain property recitations. The Examiner’s rejections, therefore, are improper and must be withdrawn.

Further regarding claims 6-11, the Examiner cited figure 2 as disclosing the outer cover layer being formed of a harder material than the inner cover layer. Figure 2, however, makes no such disclosure. Rather, it states that both the inner and the outer cover layers have a hardness greater than or equal to Shore D 60. Thus, the Examiner has provided no support for his assertions. The written description makes clear that the inner and outer cover layers are to have the same hardness, and that the hardness is at least Shore D 64:

The inner and outer cover layers have substantially the same Shore D hardness. In other words, the difference between the Shore D hardness of the inner cover layer and outer cover layer is 5 or less, and preferably is 2 or less. Each of the inner and outer layers has a Shore D hardness of at least 64.

Col. 3, lines 51-58 (reference characters omitted). Thus, the rejections of claims 6-11 are improper for this reason also, and they must be withdrawn.

The Rejections of Claims 16-20 are Improper and Must be Withdrawn

In addition to being allowable via dependence from claim 15, which has not been rejected, claims 16-20 are also allowable for at least the following reasons.

The Examiner is kindly directed to page 16 of the written description, and specifically to lines 16-29. There it is described how the present invention provides for the creation of a single cover layer having regions of different color. The Examiner is also kindly directed to Figure 8,

which shows exemplary color patterns generated via this method. The first three examples illustrate the colored additive being concentrated around poles of the golf ball (claim 19). The lower right example illustrates the colored additive being concentrated around the equator of the golf ball (claim 20). Claim 15 has been amended to require that the first and second materials are contained within a single cover layer. Sullivan '553 does not disclose nor suggest such a cover layer as described in claims 15-20. The Examiner cites Sullivan '681 to teach the inclusion of visible weighting. Again, however, there is no disclosure nor suggestion in Sullivan '681 of a single cover layer as recited in claims 15-20. The rejections of these claims, therefore, must be withdrawn.

Newly Added Claim

The Applicants have added new claim 21 above, which recites the single cover layer includes discrete portions of said first material and said second material. Support for this claim is seen, for example, on page 16 of the written description and in Figure 8. No new matter is added.

Allowable Subject Matter

The Examiner did not address claim 15 in the Office Action. Therefore, the claim has been tacitly allowed. Likewise, claims 16-20, which depend from claim 15, have also been tacitly allowed.

Additional Fees

The Commissioner is hereby authorized to charge any insufficiency, including a \$450 two-month extension fee and a \$50 extra claim fee, or credit any overpayment associated with this application to Swidler Berlin LLP Deposit Account No. 19-5127 (order no. 20002.0384).

Conclusion

Claim 15 has been amended and claim 21 has been added. Claims 1-21 are pending in the application, and are believed to be in condition for allowance. In view of the foregoing, all of the Examiner's rejections of the claims are believed to be overcome. The Applicants respectfully request reconsideration and issuance of a Notice of Allowance for all claims. Should the Examiner feel further communication would help prosecution, the Examiner is urged to call the undersigned at the telephone number provided below.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Sean P. O'Hanlon", written in a cursive style.

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